

Remarks

Claims 1-4 stand rejected under 35 U.S.C. §103 over U. S. Patent No. 6,354,142 to Nothhelfer et al. (Nothhelfer) in view of one of U. S. Patent No. 5,373,729 to Seigeot and U. S. Patent No. 5,182,076 to de Seroux et al.

Claim 1 is directed to a foil leak detection chamber including an edge zone which can be evacuated independent of a test chamber.

Nothhelfer, the primary reference, describes a foil detection chamber having a test chamber and an edge zone that is evacuated simultaneously and in a dependent manner.

According to the MPEP 2143, three basic criteria must be met to establish a *prima facie* case of obviousness. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references, when combined) must teach or suggest all the claim limitations. The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art, not in applicant's disclosure. *In re Vaeck*, 947 F.2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991).

Regarding claim 1, applicants respectfully submit that there is no motivation whatsoever to modify the teachings of Nothhelfer in accordance with the invention.

Nothhelfer shows a foil detection chamber having foils 2,3 which are sized such that when the chamber is evacuated, layers 12 of the foil come into contact with one another to form a seal.

In Nothhelfer the edge region of a test chamber is sealed by the action of the foils coming into contact:

The layers 12 forming intermediate space 13 do not extend into the edge regions of foils 2,3 so that the outer seal of the test chamber is affected by the edge regions of the foils with 2,3 coming into direct contact with each other as the evacuation process commences. *Nothhelfer U. S. 6,354,142, Column 2, Lines 53-58*

The Examiner is respectfully requested to explain why he believes that the skilled artisan would be motivated to add an independent edge zone evacuation feature into Nothhelfer, given the teaching of Nothhelfer that edges of a test chamber are already successfully sealed by foils coming into contact.

Far from suggesting a separately evacuable feature, Nothhelfer actually teaches against providing a separately evacuable edge zone and test chamber as is specifically claimed by the applicants. In the embodiment of Fig. 1, Nothhelfer evacuates air from a test chamber by suctioning air through a passageway extending throughout an area which the applicants would consider part of an edge zone. Thus, rather than teaching an independently evacuable edge zone and test chamber Nothhelfer teaches a *simultaneously* evacuated edge zone and test chamber in which the evacuation of the edge zone and test chamber are dependent. Nothhelfer teaches that a good seal at an edge of a test chamber is created by simultaneous evacuation of a test chamber on an edge zone. Note further in Nothhelfer, Fig. 2, that air in the edge regions, as well as in chamber will be suctioned out when air is suctioned through hose connection 22. Therefore, both embodiments of Nothhelfer teach simultaneously evacuated edge zones and test chambers.

A prior art reference that “teaches away” from a claimed invention is a significant factor to be considered in determining obviousness. *In re Gurly 27 F3d. 551 (Fed. Cir. 1994), cited in MPEP §2145*. Further, if the proposed modification or combination of the prior art would change the principle of operation of the prior art invention being modified, then the teachings of the reference are not sufficient to render the claims *prima facie* obvious. *In re Ratti 270 F2d.810 (CCPA 1959), cited in MPEP §2143.01*.

Regarding claims 2-4, claims 2-4 are patentable at least for the reason that they depend from an allowable base claim and also for the additional elements they recite.

Applicants further amend the claims to address minor informalities. Applicants claim amendments delete certain reference numerals and implement alternative claim language. Applicants do not add any limitation to any claim. Therefore, applicants claim amendments will not be considered "narrowing" claim amendments.

Accordingly, in view of the above amendments and remarks, Applicants believe the specifications and claims of the present application to be in condition for allowance and respectfully request reconsideration and passage to allowance of the application.

If the Examiner believes that contact with Applicants' attorney would be advantageous toward the disposition of this case, the Examiner is herein requested to call Applicants' attorney at the number noted below.

The Commissioner is hereby authorized to charge any additional fees associated with this communication or credit any overpayment to Deposit Account No. 50-0289.

Respectfully submitted,

WALL MARJAMA & BILINSKI LLP

Date: December 3, 2003



George S. Blasiak
Registration No. 37,283
WALL MARJAMA & BILINSKI LLP
101 South Salina Street
Suite 400
Syracuse, NY 13202
Customer No. 20874